

**REMARKS**

The Office Action dated August 16, 2007 has been received and carefully considered. In this response, no amendment is made. Reconsideration of the outstanding rejections in the present application is respectfully requested based on the following remarks.

I. **THE INFORMATION DISCLOSURE STATEMENT**

On page 2 of the Office Action, the Examiner indicated that the Information Disclosure Statement (IDS) filed on July 14, 2006 were not considered, apparently due to the number of references cited.

Applicant respectfully submits that the July 14, 2006 IDS was filed in good faith to fulfill Applicant's duty of disclosure under 37 C.F.R. § 1.56. The cited references reflected a collective knowledge of Applicant's then agent firm in the relevant field of the present application. The filing was in full compliance with 37 C.F.R. §§ 1.97 and 1.98. For example, the content of the July 14, 2006 IDS met the requirements listed in 37 C.F.R. §§ 1.98(a)(1), (a)(2) and (a)(3).

It should be noted that there is no statutory or regulatory limitations on the number of references that can be cited by an applicant. It should also be noted that the requirement for "a concise explanation of the relevance" under § 1.98(a)(3)(i) is applicable only to each reference "that is not in the English language." Under 37 C.F.R. § 1.97(b)(3), an information disclosure statement shall be considered by the Office if filed by the applicant before the mailing of a first Office action on the merits.

In view of the foregoing, it is respectfully requested that the IDS filed on July 14, 2006 be considered. It is further requested that the Examiner acknowledge consideration of the cited

references by initialing the PTO/SB/08A form and returning a copy of the initialed form to the undersigned.

II. THE ANTICIPATION REJECTION OF CLAIMS 1-22, 24-32, 37-38 AND 40

On page 2 of the Office Action, claims 1-22 and 24-26 were rejected under 35 U.S.C. § 102(b) as being anticipated by Melchione (U.S. Patent No. 5,930,764). On page 8 of the Office Action, claims 27-32, 37-38 and 40 were rejected under 35 U.S.C. § 102(e) as being anticipated by Jones (U.S. Publication No. 2004/0117300). These rejections are hereby respectfully traversed.

Regarding claim 1, the Examiner asserts that Melchione teaches a method for distributing bank cards comprising the same steps as presently claimed. Applicant respectfully submits that Melchione does not teach or suggest all the elements as recited in claim 1 and therefore cannot anticipate the claimed invention.

At least, Melchione fails to disclose “*creating a bank card including embossed information and magnetic stripe information, wherein the card is a dead bank card*” or “*distributing the dead bank card to the person*” as recited in claim 1 (emphasis added).

The Specification of the present application describes a dead bank card at paragraph [0030] as follows:

[0030] As referred to herein, “dead” bank cards refer to bank cards which are physically identical to a live bank card (i.e., are embossed or otherwise inscribed with the account holder's name, account number, and the like, and which include the appropriate magnetic stripe data), but which reflect a bank account that is not yet activated because the customer has not accepted the bank's offer for a new bank account. Therefore, such a bank card is in essence a dead card because the customer did not made an application, and at the time the bank card is distributed the customer has not yet responded positively (customer's acceptance)

to the unsolicited overture (bank's offer). The dead bank card is capable of full functionality upon activation because it is distributed to the customer with all necessary information, including a bank account number assigned to that prospective customer before the card is sent.

Nowhere does Melchione even mention a dead bank card, let alone the method steps of creating and distributing a dead bank card as presently claimed.

The Office Action cites to Figure 16A and column 55, lines 34-43 of Melchione as allegedly disclosing "*creating a bank card including embossed information and magnetic stripe information, wherein the card is a dead bank card; and distributing the dead bank card to the person*" as recited in claim 1. However, in Figure 16A and its corresponding text, Melchione merely describes a computerized enrollment process in which a user revises or accepts the account name of record and enters a personal identification number (PIN). Based on the information received from the user, the Melchione system then embosses bank cards to be issued to the user. Those bank cards, when distributed to the user, will be live bank cards. Melchione does not describe any dead bank card which is associated with a bank account that the customer has not yet opened or accepted.

For the foregoing reasons, claim 1 should be allowable over Melchione. Claims 2-16, which all depend from claim 1, should also be allowable for at least the same reasons. Furthermore, these dependent claims recite additional features not disclosed by Melchione. For example, Melchione does not teach or suggest "*wherein the pool is identified based on the region or regions served by the bank issuing the new bank accounts*" as recited in claim 2. The portion of Melchione cited against claim 2, i.e., column 9, lines 46-51, which describes distribution of marketing leads to personal bankers within the branch, has no relevance to the selection of potential new account holders within a bank's service region(s) ("footprint").

Similar arguments apply to the rejection of claims 17-26. Since Melchione fails to teach or suggest “*distributing a live credit card and a dead bank card to the customer if the application is approved and the customer is not an existing bank account holder*” as recited in independent claim 17, Melchione cannot anticipate claim 17 or its dependent claims 18-26.

In rejecting claim 17, the Examiner notes that “current reference (i.e., Melchione) has system to distribute live card (secured) to existing account holder and live card and dead card (which need to be activated) to the new customer” (Office Action at page 6). Judging from this statement, Applicant respectfully submits that the Examiner may have misunderstood the meanings of “live credit card” and “dead bank card” as used in claims 17-26.

The live-dead distinction should not be confused with the secured-unsecured or activated-inactive distinctions as they are traditionally understood in the credit card business. In Melchione and as generally understood, a secured credit card is one whose issuance is conditioned upon a verification of available assets or funding source that the issuer can look to in order to satisfy unpaid card balances. An unsecured credit card is one that is issued based on an approved line of credit and without any requirement of collateral assets. Card activation, as generally known in the art, is some form of acknowledgement from a cardholder that a new card has been received by the correct recipient. Thus, traditional card activation is just a security mechanism against loss or theft of new cards during shipment.

The Examiner is respectfully referred to the description of “dead bank cards” in paragraph [0030] of the present application, which is also quoted above. A dead bank card is not merely an inactive card that requires activation by a cardholder. In Melchione and in general, an inactive card is already associated with a live account that the cardholder has established with the card-issuer. The card is inactive merely for the safety of mailing it to the cardholder. In other

words, the inactive card itself, though not yet usable for purchases, does represent an existing relationship between the cardholder and the card-issuer. However, a “dead” bank card, in accordance with at least one embodiment of the present invention, represents a solicitation for future account relationship to be established between the issuer and the person receiving the dead card. The card is dead in the sense that it is not associated with a live account at the time of issuance. As a result, in order to turn the dead bank card into a live one, the person receiving the dead bank card must not only acknowledge receipt of the card but also accept the offer of a new account associated with that card.

With this understanding of the “dead bank card,” the Examiner may now appreciate the distinction between the present invention and Melchione. Since an inventor is generally allowed to create his or her own lexicon, it is believed that the term “dead bank card,” which has been properly described in the Specification, conveys a definite meaning in the claims.

For the foregoing reasons, claim 17 should be allowable over Melchione. Claims 18-26, which all depend from claim 17, should also be allowable for at least the same reasons.

Regarding claim 27, the Examiner asserts that Jones teaches a method of distributing solicited credit cards and unsolicited bank cards comprising the same steps as presently claimed. Applicant respectfully submits that Jones does not teach or suggest all the elements as recited in claim 27 and therefore cannot anticipate the claimed invention.

At least, Jones fails to disclose “*distributing a live credit card and a dead bank card to the customer if the application is approved and the customer is not an existing bank account holder*” or “*processing a customer response to the dead bank card*” as recited in claim 27 (emphasis added).

The Office Action (at page 9) cites Figures 4, 5A-B, paragraphs [0074] and [0075] from Jones as allegedly disclosing distributing a dead bank card to the customer and processing a customer response to the dead bank card. However, in Figure 4, Jones merely shows a process of approving in-store customer applications for either a private label credit card (PLCC) or a dual card. In Figures 5A-B, Jones merely shows a process of upgrading a customer's PLCC account to a dual card account. In paragraphs [0074] and [0075], Jones describes two ways dual card accounts may be issued, that is, either as upgraded accounts or as new accounts. In none of the cited portions, or anywhere else, does Jones disclose or even suggest a dead bank card as presently claimed, let alone any method steps involving the same. When a dual card account is created by upgrading a customer's PLCC account (*see* Figures 5A-B), the customer's existing PLCC card is not a dead bank card since it is already actively linked to the PLCC account. When a PLCC card or a dual card account is created as a new account (*see* Figure 4), the new account is established first (in steps 148 or 156) before a new card is sent to the customer (in step 164). Jones simply does not mention any dead bank card that is distributed to a customer prior to an establishment of the associated bank account.

For the foregoing reasons, claim 27 should be allowable over Jones. Claims 27-36, which all depend from claim 27, should also be allowable for at least the same reasons.

Regarding claim 37, the Examiner asserts that Jones teaches a method of distributing bank cards by a sponsoring bank comprising the same steps as presently claimed. Applicant respectfully submits that Jones does not teach or suggest all the elements as recited in claim 37 and therefore cannot anticipate the claimed invention.

At least, Jones fails to disclose "*creating a universal bank card including embossed information and magnetic stripe information, the universal bank card including a universal bank*

*account number to be associated by the person with an existing bank account held by a bank other than the sponsoring bank* or “*distributing the universal bank card to the person*” as recited in claim 37 (emphasis added).

The Office Action (at page 10) cites Figures 2A, 2B and 4 from Jones as allegedly disclosing the steps of creating and distributing a universal bank card. However, none of these drawings show the creation or distribution of a universal bank card which the recipient can associate with “*an existing bank account held by a bank other than the sponsoring bank.*” Jones refers to two types of accounts, PLCC accounts and dual card accounts, and they are always described as being hosted by the same issuer. *See e.g.*, Jones at Figure 1 (Private Label Account Data 36 and Dual Card Account Data 46 are housed in a private label processing platform 30 and a bank card processing platform 40, respectively, both of which are within the same issuer 24). Jones simply makes no reference to a universal bank card concept as Jones never mentions linking a card to an account that is not held with the issuer.

For the foregoing reasons, claim 37 should be allowable over Jones. Claims 38-40, which all depend from claim 37, should also be allowable for at least the same reasons.

In view of the foregoing, it is respectfully requested that the aforementioned anticipation rejection of claims 1-22, 24-32, 37-38 and 40 be withdrawn.

### III. THE OBVIOUSNESS REJECTION OF CLAIMS 23, 33-36 AND 39

On page 11 of the Office Action, claim 23 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Melchione in view of Strock (U.S. Pub. No. 2004/0122736). On page 12 of the Office Action, claims 33-36 and 39 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Jones in view of Strock (U.S. Pub. No. 2004/0122736).

These grounds of rejection has become moot in view of the deficiencies of the primary references Melchione and Jones as discussed above. Since the secondary reference Strock, by itself or in combination with the primary references, does not remedy the deficiencies in Melchione or Jones (i.e., lack of disclosure of "*a dead bank card*" or "*a universal bank card*"), the combination of Strock with Melchione or Jones cannot render the claimed invention obvious.

In view of the foregoing, it is respectfully requested that the aforementioned obviousness rejection of claims 23, 33-36 and 39 be withdrawn.

IV. CONCLUSION

In view of the foregoing, it is respectfully submitted that the present application is in condition for allowance, and an early indication of the same is courteously solicited. The Examiner is respectfully requested to contact the undersigned by telephone at the below listed telephone number, in order to expedite resolution of any issues and to expedite passage of the present application to issue, if any comments, questions, or suggestions arise in connection with the present application.

Please charge any shortage in fees due in connection with the filing of this paper to Deposit Account No. 07-1700, and please credit any excess fees to the same deposit account.

Should the Examiner believe anything further is desirable in order to place the application in even better condition for allowance, the Examiner is invited to contact Applicant's undersigned representative at the telephone number listed below.

Respectfully submitted,  
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Dated: September 3, 2007